

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 09/975,672
Filed : October 10, 2001
Applicant : Norman F. Sheppard Jr., et al.
Title : Microchip Reservoir Devices Using Wireless
Transmission of Power and Data

TC/AU : 3763
Examiner : Phillip Gray

Docket No. : 17509-0019
Customer No. : 29052

DECLARATION UNDER 37 CFR 1.132

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, John T. Santini Jr., hereby declare that:

1. I am the President and CEO of MicroCHIPS, Inc., which is the assignee of rights in the above-identified patent application. I have a Ph.D. in chemical engineering from Massachusetts Institute of Technology and over 13 years of experience in the development of micro-reservoir based devices for the protection and selective release or exposure of chemical molecules and other materials. I am an inventor on 18 issued U.S. patents directed to this technology.

2. I have reviewed the Office Action mailed June 21, 2006, and the Advisory Action mailed October 23, 2006, in connection with the present patent application. I also reviewed U.S. Patent No. 6,123,861 by Santini Jr., et al. upon which the Examiner bases his rejection of claims 26-34, 36-39, 43, 56, 59, and 61-66. I am the lead inventor on the '861 patent and am intimately

familiar with its disclosure. The Examiner's explanation for the rejection indicates a substantial misunderstanding of that disclosure, and the rejection is completely improper.

3. The Examiner alleges that "the sensor could be located in the reservoir" and that "as described in columns 8-11 the biosensor is part of a release system." (Page 2, Advisory Action). This is simply an inaccurate reading of the '861 Patent disclosure as a whole. The '861 Patent describes the use of a biosensor (in FIG. 3; col. 7, lines 28-44; and col. 12, lines 8-59) to control the activation/opening of reservoirs to initiate release of the chemical molecules disposed therein. However, the '861 Patent clearly does not teach or remotely suggest that this biosensor could or would be ever be located inside one of the reservoirs. In the context of the '861 Patent, such a sensor placement would have rendered such a control system inoperable.

4. The Examiner's misunderstanding is based at least in part on his erroneous interpretation of the term "release system" in the '861 Patent. While the "release system" is indeed located inside the reservoirs, the release system plainly does not include the biosensor. Rather, the term "release system" refers to the *chemical* components, that is the system of molecules and matrix materials for controlled release, as defined at col. 4, line 61 to col. 5, line 63 of the '861 Patent.

5. I declare that all statements made herein of my own knowledge and belief are true and that all statements made on information and belief are believed to be true, and further that the statements are made with the knowledge that willful false statements are punishable by fine

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or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Nov. 20, 2006
Date

John T. Santini Jr.
John T. Santini Jr., Ph.D.